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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/912,289 | 07/24/2001 | Jeffrey J. Norman | 0102 | 5203 |

7590

10/28/2002

H. GORDON SHIELDS
7830 NORTH 23RD AVENUE
PHOENIX, AZ 85021

EXAMINER

SINGH, SUNIL

ART UNIT

PAPER NUMBER

3673

DATE MAILED: 10/28/2002

#2

Please find below and/or attached an Office communication concerning this application or proceeding.



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08/19/2002

H. GORDON SHIELDS
7830 NORTH 23RD AVENUE
PHOENIX, AZ 85021

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H. GORDON SHIELDS
7830 NORTH 23RD AVENUE
PHOENIX, AZ 85021

EXAMINER

SINGH, SUNIL

ART UNIT

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DATE MAILED: 07/03/2002

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Office Action Summary

Application No.
09/912,289

Applicant(s)
Norman et al.

Examiner
Sunil Singh

Art Unit
3673



* -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 12-24, and 26 is/are rejected.
- 7) ☒ Claim(s) 5-11 and 25 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

Information Disclosure Statement

1: The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 3, 4, 12, 19-21, 23-24, and 26 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 3 and 4, line 1, after "run off" --water-- should be inserted in order to avoid having claims that are incomplete.

Claim 12 line 1, "1" should be --11--; otherwise there is no antecedent basis for "the plurality of tee elements".

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Claim 19 line 1, "1" should be --18--; otherwise there is no antecedent basis for "the vertically disposed retaining wall"

Claim 23 lines 1-2, "a plurality of relatively short stepped retaining walls" is recited; claim 22 lines 1-2, "a stepped retaining wall" is recited; it is unclear if they are related:

Claim 24 lines 1-2, "the stepped retaining walls" is recited; however it is unclear how it relates to the retaining wall recited in claim 22 and the plurality of retaining walls recited in claim 23.

Claim 26 line 2, "the structural tee elements" is recited; it is unclear how it relates to the "plurality of structural tee elements" recited in claim 25 lines 1-2.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-3, 13-15 and 18-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Scoville (US 2701027).

Scoville discloses an underground retention apparatus comprising in combination perimeter support means (this is considered as the top half of the vertical part of members (11,18,21)) for providing structural support; liner means (this is considered as the bottom half of the vertical part of members (11,18,21) and the bottom of member 11) secured to the perimeter support means for holding a quantity of run off water; means (16) for draining run off water onto

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the liner; means for draining the run off water from the liner ((22), see col. 2 line 16+); and roof means (15) disposed on the perimeter support means for covering the liner and for providing structural support for appropriate usage of the roof means.

(Re claims 2, 18), the perimeter support means (this is considered as the top half of the vertical part of members (11,18,21)) comprises a generally vertically retaining wall (see Figs. 1,2).

(Re claim 3), the means for draining run off from the liner includes a dry well (see col. 2 line 34).

(Re claim 13), the liner means includes an upper side wall portion (this is considered as a top portion of the bottom half of the vertical part of members (11,18,21)), a lower side wall portion (this is considered as a bottom portion of the bottom half of the vertical part of members (11,18,21)), and a bottom portion (this is considered as the bottom of member 11).

(Re claims 14,15), since applicant does not specify with respect to what reference point the term shallow angle and steep angle are measured to; it appears based on Figures 3 and 4, that Scoville discloses that the upper side wall portion is disposed at a relatively shallow angle and that the lower side wall portion is disposed at a relatively steep angle.

(Re claim 19), the liner means is secured to the vertically disposed retaining wall.

(Re claim 20), the retaining wall is considered to be relatively short.

(Re claim 21), the retaining wall is considered to be relatively long.

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(Re claim 22), the perimeter support means includes a stepped retaining wall (this is considered as part of member (13) depicted in Figure 2 as well as the top half of the vertical part of members (11,18,21)).

(Re claim 23), the perimeter support means includes a plurality of relatively short stepped retaining walls (see Fig. 4, wherein there are a plurality of retaining walls shown).

(Re claim 24), the liner means is secured to the stepped retaining walls.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 16,17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scoville '027.

Scoville discloses the invention substantially as claimed. However, Scoville is silent about the liner being made out of either plastic or cementitious material. The examiner takes official notice that it is well known to make liner/reservoir out of plastic or cementitious material. It would have been considered obvious to one ordinary skill in the art to modify Scoville by making his liner out of plastic or cementitious since such material are known to be used to make liners in order to have liner/reservoir that would not be subject to rust. Furthermore, it has been held to be within the

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general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

8. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Scoville '027 in view of Bohnhoff (US 6095718).

Scoville '027 discloses the invention substantially as claimed. However, Scoville lacks having a pump to drain the water run off from the liner. Bohnhoff teaches having a pump (34) to drain water run off from a reservoir. It would have been considered obvious to one of ordinary skill in the art to modify Scoville to include a pump as taught by Bohnhoff in order to facilitate the transport of the water run off to a desired location.

Allowable Subject Matter

9. Claims 5-11 and 25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. Claims 12 and 26 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

11. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

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Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sunil Singh whose telephone number is (703) 308-4024. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Shackelford, can be reached on (703) 308-2978. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7687.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2168.

Sunil Singh



Patent Examiner

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6/21/02